

REMARKS

Favorable consideration of this application, as presently amended, and in light of the following discussion is respectfully requested.

The Office Action of February 26, 2003 in the parent application did not acknowledge receipt or consideration of the Supplemental Amendment filed January 22, 2003 a copy of which is enclosed along with the date-stamped filing receipt as Attachment A. Accordingly, entry of this amendment is respectfully requested.

In parent application serial no. 09/238,155 Claims 1-4, 9-10, 14-16, 18, 21-24, 26, 29-30, 53 and 55 were rejected under 35 U.S.C. § 112, second paragraph, as being vague and indefinite; Claims 1, 2, 9-10, 14-16, 18, 21-26, 29-31, 33, 35, 37, 39, 43-51 and 53-56 have been rejected under 35 U.S.C. § 103 as being unpatentable over Lyden et al. (U.S.P. 5,625,964) in view of Frachey et al. (U.S.P. 5,092,060) and Claims 3 and 4 have been rejected under 35 U.S.C. § 103 as being unpatentable over Lyden in view of Frachey and Chee (U.S.P. 5,384,977). Claims 1-4, 9, 10, 14-16, 18, 21-24, 26, 29-31, 33, 35, 37, 39 and 43-51 remain active.

The discussion granted by Examiner Stashick in parent application serial no. 09/238,155 is hereby acknowledged and is sincerely appreciated. During such discussion, it was mutually agreed that by amending Claim 1 as now amended, such Claim would appear to patentably define over the prior art of record. It was also suggested that corresponding amendments be made to independent Claims 57 and 59 to more clearly define over the prior art of record. Similar amendments have been made to independent Claim 31. These amendments have now been made and it is therefore submitted that in view of the above-noted discussion and the remarks set forth here and below, the

application can now be found to be in condition for allowance. The Examiner is invited to call Applicants' attorney should any questions arise with regard to this amendment, however.

Considering first then the rejection of Claims 1-4, 9-10, 14-16, 18, 21-24, 26, 29-30, 53 and 55 under 35 U.S.C. § 112, second paragraph, as being vague and indefinite, it is to be noted that the language objected to by the Examiner has now been appropriately amended so as to correctly claim that the first and second casings are interconnecting by a bridging portion for permitting flexibility between the first and second casing and that the deformable elements are interconnected by integral bridging portions for permitting flexibility between the deformable elements. Insofar as support for the above-noted language is provided, for example, on page 15, lines 2-19, page 16, lines 1-6 and page 4, line 27 through page 5, line 17, it is submitted that the amended claim language finds full support in the specification of the present application.

Next considering then the rejection of Claims 1, 2, 9-10, 14-16, 18, 21-26, 29-31, 33, 35, 37, 39, 43-51 and 53-56 under 35 U.S.C. § 103 as being unpatentable over Lyden in view of Frachey, it is to be noted that each of independent Claims 1, 31, 57 and 59 specify that the insert is mounted in the lower support (Claims 1 and 57) or claims the insertion of elements into *first and second casings positioned in the midsole of the article of footwear* (Claims 31 and 59). In addition, it is noted that Claim 49, for example, claims a step of inserting the inserts so as to have at least one heel element and a forefoot pad positioned inwardly from adjacent borders of the midsole *so as to permit encapsulation thereof in the midsole*. Based upon the foregoing, it can be appreciated that the insert, casing and elastically deformable elements are positioned in the lower support of the footwear.

By comparison, it is noted that Lyden et al. specifically indicates at column 16, lines 12-44 that bladder 309 including each of bladders 311, 313, 315 and 317 is a *fixed or bonded* (such as by adhesive) *directly to the bottom of the midsole 307*. In addition, bladder 309 is specifically indicated as extending coextensively with the midsole 307, has a relatively thin profile, and has an internal three-dimensional (3-D) fabric positioned therein wherein the fabric is bonded to the upper and lower internal walls of the chamber envelope and serves as a tensile strength member *for maintaining the upper and lower walls as smooth substantially planar surfaces*. As also explained at column 16, lines 45-67, in a preferred embodiment, bladder 309 is constructed from pieces of knit nylon 3-D fabric, the 3-D fabric having a pair of spaced fabric layers joined to one another by a plurality of threads referred to as drop threads wherein the barrier film layers are secured to the outwardly facing surfaces of the faced fabric layers and a hot melt film is interposed between the two layers of the barrier film and functions as an adhesive to help secure the barrier film to the upper and lower surface of the fabric.

In view of the foregoing, it can be clearly understood that the bladder 309 including additional bladders 311, 313, 315 and 317 are all specifically required to be positioned so as to be affixed or bonded directly to the bottom of the midsole 307 and thus do not teach an insert, bladder or plurality of deformable elements *mounted in a lower support of the article of footwear or in a sole portion of the article of footwear* as presently claimed. Moreover, there is no teaching or disclosure in Lyden et al. in the embodiment referred to by the Examiner of the insert and the elements thereof being positioned so as to be elastically deformable such that the biometrics of a foot of a user are optimized so as to permit bridging portions between the casings to permit

flexibility of the bridging portions being aligned with the flex line of the foot of the user.

With respect to Frachey et al., such is also deficient with respect to the above-noted structure and suggests that if an insert is used, such is positioned in the sole rather than being fixed or bonded directly to the bottom of a midsole in the manner suggested by Lyden et al. It can thus be appreciated that Frachey et al., if attempted to be combined with Lyden et al., such would destroy Lyden et al. for its intended purpose and function. Moreover, due to the different location of the insert in Frachey et al. as compared with Lyden et al., such would clearly not be obviously combinable therewith to one of ordinary skill in the art.

In view of the foregoing, it is submitted that each of independent Claims 1, 31, 57 and 59 patentably define over the above-noted references as well as the remaining references of record.

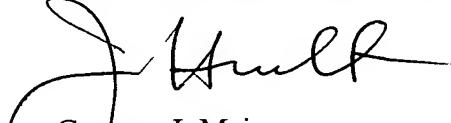
It is further submitted that each of the claims dependent upon the above-noted independent claims contain limitations having no corresponding teaching or disclosure in the prior art. In view of these limitations and based upon the dependency of these claims upon the above-noted independent claims, it is submitted that such dependent claims also merit indication of allowability.

Considering next then the rejection of Claims 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Lyden et al. and Frachey and Chee, it is submitted that Chee does not rectify the deficiencies noted hereinabove with regard to either Frachey et al. or Lyden et al., as is clearly apparent insofar as Chee has been cited solely for the teaching of locating cored cushioning elements within a sole, which again is contrary to the teachings or disclosure of the basic references of Lyden et al. and thus would not be obviously combinable therewith.

In view of the foregoing and in view of the fact that the only amendments made to the claims are for the purpose of overcoming the rejection of the claims under 35 U.S.C. § 112, entry of this Amendment After Final Rejection is believed to be in order and the same is hereby respectfully requested. In addition, in view of the foregoing discussion in support of the patentability of the claims, an early and favorable Office Action is believed to be in order and the same is hereby respectfully requested.

Respectfully submitted,

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Marked-Up Copy
Serial No: NEW CONTINUATION APP
Amendment Filed on: 6-26-03

Please amend Claims 1, 18, 29, 31, 39, 43, 44, 45, 47, 49, 50, 57 and 59 to
read as follows:

1. (Amended) An article of footwear, which comprises:

a vamp;

a lower support connected to said vamp, said lower support including a midsole; and

at least one insert mounted in said midsole [lower support] and which includes first and second airtight casings each having a plurality of elements positioned therein which are elastically deformable such that the biomechanics of a foot of a user are optimized [wherein said deformable elements comprises at least two batteries of said deformable elements], said first and second casings being interconnected by a bridging portion for permitting flexibility between said first and second casings, said deformable elements being interconnected by integral bridging portions for permitting flexibility between the [first and second casings] deformable elements, said deformable elements each having a substantially oval-shaped horizontal cross-section, and wherein said bridging portion of said first and second casings is aligned with a flex line of the foot of the user.

18. (Amended) An article of footwear as claimed in Claim 1, wherein said elements include an element located in a heel portion of the [sole] midsole and wherein said at least one element has a stiffness greater than said element located at

the heel portion of the [sole] midsole so as to reduce the degree of pronation of the foot of the user during running.

29. (Amended) An article of footwear as claimed in Claim 1 [11], wherein said insert comprises a heel cushioning element positioned inwardly from an adjacent border of the sole to permit full encapsulation of said element in the [sole] midsole.

31. (Amended) A method of forming an insert for an article of footwear, which comprises:

forming at least one insert from a plurality of interconnected elements; inserting said elements into first and second casings so as to be positioned in a [sole] midsole portion of an article of footwear such that the biomechanics of a foot of a user wearing the article of footwear are optimized wherein the step of forming the interconnected element comprises forming at least two batteries of deformable elements so as to be respectively positioned in said first and second casings wherein said deformable elements are each substantially oval-shaped in horizontal cross-section, the step of forming the elements comprises forming at least two batteries of said deformable elements, and

interconnecting said first and second casings by a bridging portion [aligned with a flex line of the foot of the user] wherein the step of forming the deformable elements comprises interconnecting said deformable elements by integral bridging portions.

39. (Amended) The method as claimed in Claim 31, wherein the step for forming the elements comprises forming the elements so as to include an element located in a heel portion of the [sole] midsole and forming at least one of said elements so as to have a stiffness greater than the element located at the heel portion of the [sole] midsole so as to reduce a degree of pronation of the foot during running.

43. (Amended) The method as claimed in Claim 31, wherein the step of inserting at least one insert comprises inserting at least one insert in a central heel cushioning portion of the [sole] midsole and locating a lateral cushioning portion in the sole with a hinge portion interconnecting the central heel cushioning portion and the lateral cushioning portion so as to absorb impact forces from the heel portion of the foot and to reduce leveraged acceleration of the [sole] midsole towards the ground as well as a rate of pronation.

44. (Amended) The method as claimed in Claim 31, wherein inserting the insert comprises inserting a heel insert into the [sole] midsole having a central heel portion, a lateral cushioning portion and a hinge portion interconnecting the central heel portion and said lateral cushioning portion.

45. (Amended) The method as claimed in Claaim 44, which comprises distancing a rear lateral border portion of said insert from an outside border [of a sole] of the shoe and the midsole to permit encapsulation of the insert with the foam member.

47. (Amended) The method as claimed in Claim 31, wherein the step of inserting the insert comprises inserting an insert having a plurality of cushioning elements located at a rear portion of the heel and at least one laterally positioned forefoot element to reduce any tendency of the sole to collapse under a forefoot lateral border portion on the [sole] midsole during a cutting motion of the user when running.

49. (Amended) The method as claimed in Claim 31, wherein the step of inserting the insert comprises inserting an insert having at least one heel element and a forefoot pad positioned inwardly from adjacent borders of the [sole] midsole so as to permit encapsulation thereof in the [sole] midsole.

50. (Amended) The method as claimed in Claim 31, wherein the step of inserting the insert comprises inserting a heel cushioning element positioned inwardly from an adjacent border of the [sole] midsole to permit full encapsulation of the element in the [sole] midsole.

52. New.

53. New.

54. New.

55. New.

56. New.

57. New.

58. New.

59. New.

60. New.